REMARKS

Claims 1 and 20 - 103 Rejection - Fleming '204 in view of Daniele EPO Appl. '074 and in further view of McConnell '295.

I. Neither Daniele Nor McConnell Discloses the Added Claim Limitation.

Claims 1 and 20 have been amended to define a fundamental difference between the subscription fee payment method in the invention and the compulsory license/R.R.O. payment methods shown in McConnell and Daniele.

Specifically, in step two of each claim, it is further defined that the users pay subscription fees *to the database maintainer unrelated to the usage of a specific material*. This is fundamentally different than a compulsory license or R.R.O. arrangement, because the Copyright Office and R.R.O.s do not maintain a database of materials that they provide to users. In a compulsory license or R.R.O. arrangement, you pay fees to the Copyright Office or the R.R.O., but they don't then provide you with the materials. Instead, you go out and access the materials yourself, albeit secure in the knowledge that you are doing so legally. See Fig. 1 in Daniele and discussion in McConnell, wherein it's clear that the R.R.O. and the Copyright Office merely grant a license in exchange for the license fee - they don't provide the materials.

II. Fleming Also Does Not Disclose the Added Claim Limitation.

A. Fleming Does Not Disclose Subscription Fees.

The 7/21/04 Office Action concedes that Fleming does not disclose subscription fees. See page 4, lines 6-7: "Fleming, III, however, fails to specifically disclose wherein the plurality of users pay subscription fees to access the database". The Office Action instead relies on Daniele for the subscription fee feature. See page 4, lines 10-12: "Daniele discloses a method...wherein a user pays a subscription fee for estimated copyright copies". But as shown above, even if Daniele can be relied on to add the subscription fee feature missing in Fleming, Daniele does not disclose subscription fees that are paid to the database maintainer – i.e., the provider of the materials.

B. Even If Fleming Disclosed Subscription Fees, He Does Not Disclose Subscription Fees Unrelated to the Usage of a Specific Material.

Amended Claims 1 and 20 further define that the subscription fees are *unrelated to the usage of a specific material*. This is very different than Fleming, which discloses just the opposite. The fee mention in Fleming is expressly limited to fees related to usage of a specific material – i.e., a specific file or executable program. See various passages in col. 1, lines 46-67 and col. 2, lines 1-16: "[T]he total usage of a computer system resource is important for a resource with an attribute or characteristic *related to usage*"; "[A] fee can be charged *based on the usage* of a computer system resource, such as a file or executable program that is leased on a *per-use basis*"; "Thus, if an advertisement were attached to or associated with a file being viewed by users, the time spent viewing the file would be an important attribute *related to usage*".

III. It Would Not Be Obvious to Modify Fleming to Meet the Amended Claim.

Since Fleming's entire focus is to provide a way to measure usage of a particular computer file or program, it is not surprising that he thinks about fees only in that way – related to usage of a specific material. Thus, it would not be obvious to modify Fleming to have fees that are *unrelated* to usage of a specific material. Not only does Fleming teach against this, but also such a modification would significantly change Fleming's principles of operation. MPEP 2143.01 states: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F. 2d 810, 123 USPQ 349 (CCPA 1959)".

In summary, since neither Fleming nor Daniele nor McConnell discloses the added claim limitation, no combination of these three references would disclose it, and it would be unobvious to modify Fleming yet again to meet the amended claim. Finally, since independent claim 1 defines patentably over the prior art, its dependent claims 2-15 also define patentably for the same reasons.

CONCLUSION

For all of the above reasons, Applicant submits that the claims all define patentably over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action they respectfully solicit.

Very respectfully,

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6 October 2004

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